

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,298

GESELLSCHAFT FÜR BIOTECHNOLOGISCHE FORSCHUNG MBH¹
(09/313,524),
Junior Party,

v.

SLOAN-KETTERING INSTITUTE FOR CANCER RESEARCH²
(6,242,469 B1 and 6,284,781 B1),
Senior Party.

Entered: 27 July 2005

ORDER - Bd.R. 104(a) - Miscellaneous
(Clarifying basis of redeclaration (Paper 19))

Before TORCZON, Administrative Patent Judge.

During the conference call described in Paper 28, Paul Richter requested a clarification of the reason for designating GBF's claim 15 as not corresponding to the count. Claim 15 states (Paper 12 at 3):

A composition for plant protection in agriculture, forestry or horticulture comprising a compound according to claim 20 in combination with at least one carrier or diluent.

The parties had agreed that claim 15 should not be designated as corresponding to the count (Paper 18 at 1). The interference was redeclared to designate claim 15 as not

¹ Bristol-Myers Squibb Co., exclusive licensee.

² Kosan Biosciences, Inc., licensee; Hoffman-La Roche Inc., sublicensee.

corresponding, without prejudice to the examiner later presenting a case for why the subject matter of claim 15 might have been obvious (Paper 19).

Mr. Richter explained that the basis for the agreement between the parties that claim 15 did not correspond lies in the preamble phrase "for plant protection in agriculture, forestry or horticulture", which the parties agree is limiting, rather than in the use of "at least one carrier or diluent". Mr. Casieri confirmed this understanding on behalf of GBF. Mr. Richter expressed concern that this understanding of the parties be reflected in the GBF application record.

ORDERED that a copy of this order be entered in GBF's 09/313,524 application.

cc (via electronic mail):

For Gesellschaft für Biotechnologische Forschung mbH: **Diane Dunn McKay, Kristine Butler-Holston**, and **Christopher Casieri**, MATHEWS, SHEPHERD, MCKAY & BRUNEAU, P.A., of Princeton, New Jersey.

For Sloan-Kettering Institute for Cancer Research: **Richard L. DeLucia**, KENYON & KENYON, of New York, New York; and **Brenda H. Jarrell**, CHOATE, HALL & STEWART, of Boston, Massachusetts.

Desperтт, Sonja

From: Desperтт, Sonja on behalf of Interference Trial Section
Sent: Wednesday, July 27, 2005 5:43 PM
To: 'Butler-Holston, Kristine (MATHEWS SHEPHERD)'; 'Casieri, Christopher (MATHEWS SHEPHERD)'; 'DeLucia, Richard (KENYON & KENYON)'; 'Dunn McKay, Diane (MATHEWS SHEPHERD)'; 'Jarrell, Brenda (CHOATE HALL)'
Subject: Interference No. 105298 (RT) Paper No. 28 - Order-Bd.R. 121(a) and Paper No. 29 - Order-Bd.R. 104(a)



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